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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,845	05/17/2006	Walter Rosenbaum	2004P19118	5727
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EXAMINER				
CHEN, GEORGE YUNG CHIEH				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,845

Applicant(s)

ROSENBAUM, WALTER

Examiner

George Chen

Art Unit

3628

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11, 13, 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. DETAILED ACTION

2. This communication is a non-final action in response to amendment filed on 11/18/2010. Claims 1-5, 7-11, 13, 14 are pending.

3. Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 7, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huxter (US 20020107820 A1) in view of Mayer et al. (hereinafter Mayer, US 20050015349 A1) further in view of Lubart (US 20050192913 A1).**

6. As per claim 1, Huxter discloses a method of forwarding post, comprising the steps of:
- ✓ scanning an address face of the post for a TAG ID specific to the post (see at least Huxter, 0192, central console then prompts him to either enter the Parcel ID for the package or present the bar-code for scanning.)
 - ✓ consulting a database for records related to the TAG ID, wherein the records contain information indicating if said TAG ID is expired (see at least Huxter, 0207, the central console marks the Parcel ID of that package as expired on its orders database)
 - ✓ if the TAG ID specific to the post is expired (see at least Huxter, 0207, the central console marks the Parcel ID of that package as expired on its orders database):

Huxter does not explicitly disclose

- ✓ automatically determining if an addressee of the post maintains a forwarding service account, and
- ✓ if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address in the forwarding service account

Huxter, however, discloses returning the parcel when TAG ID is expired (see at least Huxter, 0207, server sends notification to the relevant delivery companies that return collections are required).

Mayer teaches that automatically forwarding shipments as an alternative to returning shipments that are stored in the locker (see at least Mayer, 0138, Return shipments are shipments that have exceeded the storage period and that are then forwarded or else send back to the sender).

Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself. That is in the substitution of forwarding of Mayer for the return of Huxter. Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

Mayer does not explicitly teach debiting account in appropriate amount for forwarding service.

Lubart teaches if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address in the forwarding service account (see at least Lubart, 0014, the follow me mail service allows a user to define where mail objects that are addressed to a registered pseudo name are delivered. a user can modify their profile. And see at least 0078, if a mail object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service).

One of ordinary skill in the art would have recognized that applying the known technique of Lubart to Huxter would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Lubart to the teaching of Huxter would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such fee collection. Further, applying fee collection to Huxter, would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more revenue generation (Lubart 0078).

7. As per claim 7, claim 7 contains limitation substantially similar to that of claim 1 and is herein rejected under similar rationale as set forth above.
8. As per claim 14, Huxter discloses the method according to 1 but does not explicitly disclose wherein the post is an item of mail.

Lubart teaches wherein post is an item of mail (see at least Lubart, see at least 0078, if a mail object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service).

One of ordinary skill in the art would have recognized that applying the known technique of Lubart to Huxter would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Lubart to the teaching of Huxter would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such fee collection. Further, applying application to mail object to Huxter, would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more revenue generation (Lubart 0078).

9. Claims 2-3, 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huxter in view of Mayer et al. further in view of Lubart, even further in view of Nielsen (US 6405243 B1).

10. As per claim 2, Huxter discloses the method according to claim 1, but does not explicitly disclose further comprising the step of automatically offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account. Nielsen does not explicitly teach offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account. Nielsen, however, teaches offering a forwarding service to customer if said customer does not maintain a sufficient funded service account (see at least Nielsen, Fig. 3, step 315-323, wherein sender will be asked to pay for update if there is no sufficient fund in account).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account because having the forwarding service would not take into effect if the account is under funded, as if the user has never registered in the first place.

One of ordinary skill in the art would have recognized that applying the known technique of Nielsen to Huxter would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Nielsen to the teaching of Huxter would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to Huxter would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more revenue generated from customers.

11. As per claim 3, Huxter discloses the method according to claim 2, but does not explicitly disclose comprising the step of not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account

Mayer teaches not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding account (see at least Mayer, 0138, Return shipments are shipments that have exceeded the storage period and that are then forwarded or else send back to the sender).

One of ordinary skill in the art would have recognized that applying the known technique of Mayer to Huxter would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Mayer to the teaching of Huxter would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such process. Further, applying not forwarding post to an address destination if no forwarding account exist to Huxter, would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more efficient operation because a standard procedure is decided as to how to dispose the post.

12. As per claim 8, claim 8 contains limitation substantially similar to that of claim 2 and is herein rejected under similar rationale as set forth above.

13. As per claim 9, claim 9 contains limitation substantially similar to that of claim 3 and is herein rejected under similar rationale as set forth above.

14. Claims 4, 10, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huxter in view of Mayer et al. further in view of Lubart, even further in view of Nielsen even more further in view of Kuebert et al. (hereinafter Kuebert, US 20020165729 A1).

15. As per claim 4, Huxter discloses the method according to claim 3, but does not explicitly disclose wherein said step of not forwarding further comprises the step of destroying the post.

Kuebert teaches step of not forwarding further comprises the step of destroying the post (see at least Kuebert, 0055, alternatively, the sender may instruct the shipper to destroy mail item).

One of ordinary skill in the art would have recognized that applying the known technique of Kuebert to Huxter would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Kuebert to the teaching of Huxter would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying the step of destroying the post to Huxter would have been recognized by one of ordinary skill in the art as resulting in an improved system that would be cheaper (Kuebert, 0055).

16. As per claim 10, claim 10 contains limitation substantially similar to that of claim 4 and is herein rejected under similar rationale as set forth above.

17. As per claim 13, Huxter discloses the apparatus according to 10 but does not explicitly disclose wherein the post is an item of mail.

Lubart teaches wherein post is an item of mail (see at least Lubart, see at least 0078, if a mail object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service).

One of ordinary skill in the art would have recognized that applying the known technique of Lubart to Huxter would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Lubart to the teaching of Huxter would have yielded predictable results because the level of ordinary skill in the art demonstrated

by the references applied shows the ability to incorporate such fee collection. Further, applying application to mail object to Huxter, would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more revenue generation (Lubart 0078).

18. Claims 5, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huxter in view of Mayer et al. further in view of Lubart, even further in view of Nielsen even more further in view of Kuebert even more further in view of Webb (US 20040020978 A1).

19. As per claim 5, Huxter discloses the method according to claim 4, but does not explicitly disclose wherein said step of not forwarding further comprises a pre-selected time delay prior to destruction of said post. Huxter, however, discloses that a delay can be applied to the disposition step in case a mistake was made (see at least Huxter, 0209, the ID for the expired order is kept valid for a further 5 minutes in case the deliverer has made a mistake). Webb teaches having a pre-selected time delay prior to destruction of said post (see at least Webb, 0003-0004, when the mail box door is closed, the process is started. The process run for a prescribed time sufficient to destroy any biological organisms. The process can start after an adjustable delay.)

One of ordinary skill in the art would have recognized that applying the known technique of Webb to Huxter t would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Webb to the teaching of Huxter would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying having a pre-selected time delay prior to next action to ensure user having a pre-selected time delay prior to destruction of said post to Lubart would have been recognized by one of ordinary

skill in the art as resulting in an improved system that would consider the possibility of mistakes (see at least Huxter: 0209).

20. As per claim 11, claim 11 contains limitation substantially similar to that of claim 5 and is herein rejected under similar rationale as set forth above.

21. Response to Argument

22. Regarding Applicant's argument directed to 103 rejection

23. **Applicant's arguments, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.**

24. However, upon further consideration, a new ground(s) of rejection is made in view of Huxter and Mayer.

25. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Chen whose telephone number is (571)270-5499. The examiner can normally be reached on Mon-Thu 6:30-5:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G.C./

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628